

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

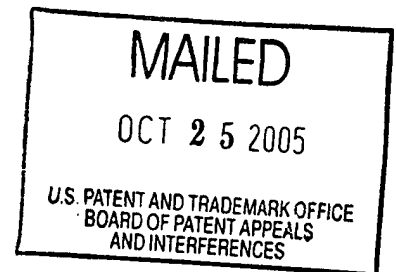
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YU-HSI WANG,
WEN-HXIANG TSENG and WEI-JEN HUANG

Appeal No. 2005-2040
Application 09/847,511

ON BRIEF



Before WARREN, KRATZ and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR § 1.41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

The principal issues in the grounds of rejection of appealed claims 1 through 4 and 7 advanced on appeal is whether each of Komatsuzaki (appealed claim 1) and Weber et al. (Weber) (appealed claims 1 and 2) as applied under 35 U.S.C. § 102(b) and as combined with other references (appealed claims 2 through 4 and 7), including Erk et al. (Erk), as applied under 35 U.S.C. § 103(a) (answer, pages 3-8), would have taught or suggested the claimed wet stripping apparatus comprising at least, among other limitations, “means for reciprocally moving said wafer holder in an up-and-down motion with said at least one wafer immersed in said stripper solution at a frequency of up to 100 cycles/min” as encompassed by appealed

independent claim 1. The resolution of these issues requires that the subject claim language must first be interpreted by giving the claim terms their broadest reasonable interpretation consistent with the written description provided in appellants' specification as it would be interpreted by one of ordinary skill in this art. See *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) ("[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification."); *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*in banc*) ("[T]he 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six," and in this respect, the examiner should not confuse "impermissibly imputing limitations from the specification into a claim with properly referring to the specification to determine the meaning of a particular word or phrase in a claim. [Citation omitted.]"); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent prosecution the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).").

We find that the claim limitation in appealed claim 1 specifies "means for" the specified function of "reciprocally moving said wafer holder in an up-and-down motion with said at least one wafer immersed in said stripper solution at a frequency of up to 100 cycles/min" but does not define structure which satisfies that function and thus, the strictures of 35 U. S. C. § 112, sixth paragraph, apply. See *Texas Digital Systems, Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir 2002), and cases cited therein. Therefore, the "means" language in this limitation must be construed as limited to the "corresponding structure" disclosed in the written description in the specification and "equivalents" thereof. *Donaldson*, 16 F.3d at 1192-95, 29 USPQ2d at 1848-50.

The “corresponding structure” is that “structure in the written description necessary to perform that function [citation omitted],” that is, “the specification . . . clearly links or associates that structure to the function recited in the claims.” [Citation omitted.]” *Texas Digital Systems*, 308 F.3d at 1208, 64 USPQ2d at 1822-23. “[A] section 112, paragraph 6 ‘equivalent[]’ . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). “[T]wo structures may be ‘equivalent’ for purposes of section 112, paragraph 6 if they perform the identical function in substantially the same way, with substantially the same result. [Citations omitted.]” *Kemco Sales*, 208 F.3d at 1364, 54 USPQ2d at 1315. “[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six,” and in this respect, the examiner should not confuse “impermissibly imputing limitations from the specification into a claim with properly referring to the specification to determine the meaning of a particular word or phrase in a claim. [Citations omitted.]” *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850; *see also Morris*, 127 F.3d 1048, 105556, 44 USPQ2d 1023, 1028 (explaining *Donaldson*).

Thus, the examiner must first interpret the “means for” claim language in order to establish a *prima facie* case of anticipation and of obviousness over the applied prior art because all of the claim limitations must be considered. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection “every limitation in the claim must be given effect rather than considering one in isolation from the others.”); *cf. Donaldson*, 16 F.3d at 1195-97, 29 USPQ2d at 1850-52.

Here, the examiner has not interpreted the “means for” language in appealed claims 1 through 7 with respect to the “corresponding structure” in the specification and “equivalents” thereof in a manner consistent with the requirements of 35 U. S. C. § 112, sixth paragraph, and made findings as to whether the structure disclosed in the specification (*see answer, e.g., pages 4, 13 and 14*).

We find that the only disclosed structure in the written description in appellants’ specification with respect to the “means for” the specified function of “reciprocally moving said

wafer holder in an up-and-down motion” within the specified cycle/min range is “wafer holder 74, or the FOUP is connected to an air cylinder assembly 76 through connecting rods” illustrated in specification **FIG. 4** as described at page 16, ¶ 0035, of the specification (see also page 8, ¶ 0017). No structure is specified in the disclosure “or any other suitable means” in the specification (page 16, ¶ 0035).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to interpret the subject claim limitation of appealed claims 1 through 4 and 7, by first determining the “corresponding structure” for the “function” in the limitation that is described in the specification, and then determining whether “equivalents” thereof are disclosed by the facts and inferences that one of ordinary skill in this art would have found in the disclosure in each of Komatsuzaki and Weber alone and as combined with the teachings of the other references, including Erk,¹ in a manner consistent with the requirements of 35 U. S. C. § 112, sixth paragraph, in order to determine whether the references are applicable to the interpreted claims under § 102(b) and/or § 103(a), and if so, setting forth the interpretation, findings and determinations in a supplemental examiner’s answer, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

We interpret appealed claims 5 and 6 to include a recitation of sufficient structure for the “means for reciprocally moving said wafer holder” such that the strictures of 35 U. S. C. § 112, sixth paragraph, do not apply. *See Texas Digital Systems*, 308 F.3d at 1208, 64 USPQ2d at 1822-23.

This remand is made for the purpose of directing the examiner to further consider grounds of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 CFR §1.41.50(a)(2) (2005), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

¹ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., Rev. 2, May 2004; 1200-30).

Remanded

Robert F. Kennedy

CHARLES F. WARREN
Administrative Patent Judge

Pety F. Kras

PETER F. KRATZ
Administrative Patent Judge

Catherine Zinn

CATHERINE TIMM
Administrative Patent Judge

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